

REMARKS/ARGUMENTS

Status Of Application

Claims 1-25 are pending in the application (the Office Action states 1-26 are pending); the status of the claims is as follows:

Claims 13-16 and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sakaegi, U.S. Patent No. 5,808,678 in view of Kubo, U.S. Patent No. 6,545,710 B1;

Claims 1-5 and 7-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sakaegi in view of Kubo further in view of Ejima, U.S. Patent No. 6,188,432 B1;

Claims 6, 11, and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sakaegi in view of Kubo and Ejima '432 further in view of Yanker, U.S. Patent No. 5,187,776;

Claims 17-19, 21-23, and 25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ejima in view of Ueno, U.S. Patent No. 5,625,415; and

Claim 20 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ejima in view of Ueno further in view of Yanker.

Claim 17 has been amended to more particularly point out and distinctly claim the invention. No new matter has been added.

35 U.S.C. § 103(c) – Statement of Common Ownership

The section 103 rejections articulated in paragraphs 4, 5, and 6 of the present Office Action cite, *inter alia*, Kubo, U.S. Patent No. 6,545,710 B1.

This present application, U.S. Ser. No. 10/041,641, and Kubo, U.S. Patent No. 6,545,710 B1, were, at the time the invention of U.S. Ser. No. 10/041,641 was made, owned by, or subject to an obligation of assignment to, Minolta Co., Ltd.

Because Kubo, U.S. Patent No. 6,545,710 B1, is available to be cited against the present application only under 35 U.S.C. § 102(e) and because Kubo is applied in the

present Office Action under 35 U.S.C. §103(a) and because the present application was filed after November 29, 1999, the guidelines of 35 U.S.C. §103(c) apply. Accordingly, under 35 U.S.C. §103(c), Kubo is **disqualified** from being used in a rejection under 35 U.S.C. §103(a) against the claims of the present application.

35 U.S.C. § 103(a) Rejections

a. Claims 13-16 and 24 over Sakaegi and Kubo; Claims 1-5 and 7-10 over Sakaegi, Kubo and Ejima; Claims 6, 11, and 12 over Sakaegi, Kubo, Ejima and Yanker:

The rejection of paragraph 4 of the office action of Claims 13-16 and 24 over Sakaegi in view of Kubo as well as the rejection of paragraph 5 of the office action of Claims 1-5 and 7-10 over Sakaegi in view of Kubo further in view of Ejima as well as the rejection of paragraph 6 of the office action of Claims 6, 11, and 12 over Sakaegi in view of Kubo and Ejima further in view of Yanker are all respectfully traversed based on the following.

Each of the above cited rejections relies, at least in part, on teachings from Kubo, U.S. Patent No. 6,545,710 B1, in order to state a *prima facie* case of obviousness of the claims. As explained above, Kubo is disqualified from being used in a rejection under 35 U.S.C. §103(a) against the claims of the present application. Accordingly, without the teachings of Kubo, each of the above cited rejections now fails to state a *prima facie* case of obviousness.

Notwithstanding the disqualification of Kubo, the above cited rejections fail to render the instant claims obvious for the additional reason that the combined references do not disclose, suggest, or teach the limitations of claim 13, from which claims 1-12 and 14-16 depend, or the limitations of claim 24. That is, claims 13 and 24 require that, *inter alia*, on one hand, an image pickup operation be based on image data in a specified position within the subject image while, on the other hand, colorimetric calculations should be performed on the image data independent of a specified position.

A brute force combination of a reference on colorimetric operations, Kubo, which does not teach designating portions of the image with a reference, Sakaegi, which teaches designating a location on the display, fails to arrive at the claimed invention. Sakaegi expressly teaches that white balance is performed in the cut out area (the designated area) col. 6, lines 2-4. Thus, not only does Sakaegi teach away from performing white balance independent of the specified location, but a combination of Sakaegi with Kubo to arrive at the claimed invention would require a change of the principle of operation of Sakaegi, which is an improper result in a section 103 combination. Kubo does not teach designating a portion of the display, much less what should be done with a designated area (if there were one) with respect to white balance calculations. Thus, Kubo is certainly unable to overcome the express teachings of Sakaegi and certainly further unable to suggest that the designated area be used for some things (e.g., AE) but not for others (e.g., WB).

In view of the above, it is respectfully requested that the rejection of paragraphs 4, 5 and 6 of the office action, (i.e., the rejection of Claims 13-16 and 24 over Sakaegi in view of Kubo as well as the rejection of Claims 1-5 and 7-10 over Sakaegi in view of Kubo further in view of Ejima as well as the rejection of paragraph 6 of the office action of Claims 6, 11, and 12 over Sakaegi in view of Kubo and Ejima further in view of Yanker), be reconsidered and withdrawn.

b. Claims 17-19, 21-23, and 25 over Ejima in view of Ueno:

The rejection of claims 17-19, 21-23, and 25 under 35 U.S.C. § 103(a), as being unpatentable over Ejima in view of Ueno, is respectfully traversed based on the following.

Claim 17 recites, in part:

an image sensor for picking up an image of a subject at a selected zoom setting and for generating a subject image;
a means for varying a zoom setting for controlling a zoom setting at which said image sensor picks up an image of a subject;
a display for displaying said subject image generated by said image sensor on a screen;
a specifying member for specifying a specific position on said screen;
an image-pickup controller for carrying out a focusing operation based upon said specified position specified by said specifying member;
and
a display controller for displaying a portion of said subject image in an enlarged manner in an enlarged area containing said specified position specified by said specifying member on said screen while maintaining said selected zoom setting for said subject image.

Thus, claim 17, as now presented requires that the device include a means for varying the zoom setting and that the image pick up be based on a selected zoom setting. Claim 17 also requires a display controller which can display a portion of the image in an enlarged manner without affecting the zoom setting. Thus, claim 17 describes a system which can vary the zoom setting, which affects how the image is captured, and which can also independently vary a display magnification, which affects how the image is displayed on the display. Significantly, in claim 17, how the display is magnified on the display does not affect the zoom setting which controls how the image is captured. Finally, claim 17 also requires that the focusing operation be carried out based upon the specified position.

Ejima teaches enlarging a selected area of a displayed image by electronically zooming. The electronic zooming operation of Ejima is the magnification on a display of a previously captured image. Ejima does not disclose, suggest or teach a mechanism for a zooming operation which affects how the image is captured by the image sensor. Ejima certainly does not disclose a mechanism for zooming which affects image capture which can be controlled independently from an enlargement which affects a magnification of a previously captured image displayed on a display. Thus, Ejima fails to disclose or suggest

this aspect of claim 17. As acknowledged in the office action, Ejima also fails to disclose, suggest or teach carrying out a focusing operation based upon the specified position.

Ueno teaches a digital camera which allows a user to specify the position in the image at which focusing operations, etc. are to be based. Ueno does not, however, disclose enlarging a display of an image, or enlarging a displayed image based on a location which has been designed for carrying out a focusing operation. Ueno is also silent on varying a zoom setting which affects the image pickup operation.

Accordingly, even if Ejima and Ueno are combined, the combination still cannot suggest the attributes of the claimed invention of enlarging a displayed image based on a location which has been designed for carrying out a focusing operation while simultaneously not affecting a zoom setting which controls how an image will be picked up by an image sensor. The references, singly or combined, simply do not suggest this combination of operations or the interaction between them.

Claims 18-23 depend from claim 17 and thus are not obvious over Ejima and Ueno for at least the same reasons as claim 17.

Claim 25 describes a method whereby a designated portion of the displayed image is used for both focusing as well as for designating a portion of the displayed image to be enlarged.

Ejima discloses enlarging a displayed image based on a designated location in the display. Ueno discloses focusing a camera based on a designated location in the display. However, nothing in Ejima or Ueno discloses or suggests that both focusing and enlarging should be based on a common designation point. Absent a suggestion in the references why a enlargement designation point should be used for focusing or a focusing point should be used for enlarging, the references cannot render claim 25 obvious.

Accordingly, it is respectfully requested that the rejection of claims 17-19, 21-23, and 25 under 35 U.S.C. § 103(a) as being unpatentable over Ejima in view of Ueno, be reconsidered and withdrawn.

The rejection of claim 20 under 35 U.S.C. § 103(a), as being unpatentable over Ejima in view of Ueno further in view of Yanker is respectfully traversed based on the following.

Claim 20 depends from claim 17. As discussed above with respect to the rejection of claim 17, claim 17 as now presented is believed to be nonobvious over Ejima and Ueno. Yanker does not overcome the deficiency of Ejima and/or Ueno to render obvious the invention of claim 17. Yanker, singly or in combination with Ejima and Ueno, does not disclose or suggest a system which, as required by claim 17, (a) can vary a zoom setting—which affects how the image is captured—and (b) can also independently vary a display magnification—which affects how the image is displayed on the display—and which (c) can change how the display is magnified on the display without affecting the zoom setting which controls how the image is captured, and (d) finally, which carries out a focusing operation based upon the specified position.

Instead, the present rejection adds Yanker for the proposition that “in the case when an area other than said subject image that has been stored is displayed on the screen by said altering member, an original subject image generated by said image sensor is displayed.”

Because Ejima, Ueno and Yanker, singly or in combination, cannot render obvious claim 17 from which claim 20 depends, these references also cannot render obvious claim 20 for at least the same reasons.

Accordingly, it is respectfully requested that the rejection of claim 20 under 35 U.S.C. § 103(a) as being unpatentable over Ejima in view of Ueno further in view of Yanker, be reconsidered and withdrawn.

The present response adds new claims 26 and 27 which depend from claim 17 which is believed to be allowable. The present response also adds new claims 28 and 29 in order to provide a more adequate basis for protecting the present invention. New claim 28 claims an image taking apparatus with two magnifications modes, a first mode where a designation point is maintained in a constant position with respect to the display during magnification of a displayed image and a second mode where a designation point is maintained in a constant position relative to a displayed image during magnification of a displayed image. The designation point in claim 28 is used as a basis for controlling an image pickup operation. The cited references, singly or in combination, fail to disclose, suggest or teach an apparatus with such a two magnification mode display characteristic. Ejima discloses a digital camera where a line drawing can be superimposed over an image. The image may be magnified independent of the line drawing or the image and line drawing may be magnified together. The line drawing of Ejima is utterly different than the designation point in claim 28, because claim 28 requires that the designation point be used to control an image pickup operation. In Ejima, the line drawing does not control an image pickup operation.

CONCLUSION

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are respectfully requested.

This Amendment increases the number of independent claims by 2 (from 4 to 6) and increases the total number of claims by 4 (from 25 to 29), but does not present any multiple dependency claims. Accordingly, a Response Transmittal and Fee Authorization form authorizing the amount of \$244.00 to be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260 is enclosed herewith in duplicate. However, if the Response Transmittal and Fee Authorization form is missing, insufficient, or otherwise inadequate, or if a fee, other than the issue fee, is required during the pendency of this

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application, please charge such fee to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260.

If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee, and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

By: _____


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